

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application of : Chris E. DiFrancesco  
Application No. : 10/801,140  
Filed : March 12, 2004  
For : Catalyst Systems  
Examiner : Thanh P. Duong  
Art Unit : 1797  
Atty. Docket : 54673-297873

Mail Stop: Issue Fee  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Petition Regarding Patent Term Adjustment (PTA)**  
**Indicated in Notice of Allowance**

Sir:

1. A Notice of Allowance was mailed on April 16, 2010 for the present application. One of the attachments to the Notice of Allowance was a Determination of Patent Term Adjustment Under 35 USC § 154(b) that indicated that the total patent term adjustment (PTA) to date is 494 days. It is believed that the correct total PTA to date is 1102 days.

2. The determination of the total PTA of 494 days is erroneous because the U.S. Patent & Trademark Office's (PTO) PTA calculator failed to account for two separate PTO delays. The two PTO delay periods should have their days added together in accordance with the reasoning in *Wyeth et al. v. Dudas*, No. 07-1492 (D.D.C. September 30, 2008), *aff'd Wyeth et al. v. Dudas*, No. 2009-1120 (Fed. Cir. Jan. 7, 2010). The number of PTA credits of 875 days for PTO delay under 35 USC § 154(b)(1)(A) and 37 CFR § 1.702(a)(1) that is shown on the PTA History (Exhibit A) is correct and agrees with the credit calculated by the PTO. However, this delay only accounts for one of the delays of the PTO. The other delay warrants a PTA credit of 813 days for PTO delay under 35 USC § 154(b)(1)(B) and 37 CFR § 1.702(b). Because these two periods of delay overlap, Applicants are entitled to the sum of these two periods minus the overlap period. Accordingly, a total PTA credit of 1483 days (i.e., 875 days + 813 days – 205

days) is appropriate based upon the PTO delay. The total number of PTA debits of 381 days for applicant delay that is shown on the PTA History (Exhibit A) is correct. Thus, the correct total PTA to date is 1102 days.

3. Thus, Applicants believe that the total PTA credit for PTO delay is 1483 days, the total PTA debit for applicant delay is 381 days, and the total PTA under 37 CFR § 1.703(f) is 1102 days.

4. In accordance with 37 CFR § 1.705(b), this application for patent term adjustment is filed no later than the payment of the issue fee but after the date of mailing of the notice of allowance.

5. The following statements are required by 37 CFR § 1.705(b)(2)(i).

- i) The correct total PTA credit is 1102 days.
- ii) The basis for the 875 days of PTA credit pursuant to § 1.702(a)(1) is due to the PTO's failure to mail a notification under 35 USC § 132 or a notice of allowance within 14 months of the application's filing date. The basis for the 813 days of PTA credit pursuant to § 1.702(b) is due to the PTO's failure to issue a patent within three years of the filing date.
- iii) The basis for the 381 days of PTA debit pursuant to § 1.704(b) is due to the Applicants' failure to reply to actions by the PTO within three months after the date on which the actions were mailed.
- iv) The total PTA under § 1.703(f) is projected to be 1102 days, which is the total PTA credit for PTO delay of 1688 days less the PTA debit for overlap of 205 days and for applicant delay of 381 days.

6. The following statements are required by 37 CFR § 1.705(b)(2)(ii).

- i) The relevant dates as specified in 37 CFR § 1.703(a)(1) for one part of the PTA credit are as follows: the date of May 12, 2005 which is the date that is fourteen months after the date on which the application was filed under 35 USC § 111(a); and the date of October 4, 2007, which is the mailing date of a notification under 35 USC § 121. Thus, the period of delay runs from May 12, 2005 to October 4, 2007. This period of delay is 875 days.
- ii) The relevant dates as specified in 37 CFR § 1.703(b) for the remaining part of the PTA credit are as follows: the date of March 13, 2007 which is the date that is three years and one day after the date on which the application was filed under 35 U.S.C. 111(a); and the date on which the Request for Continued Examination was filed on June 3, 2009. Thus, the period of delay runs from March 13, 2007 to June 3, 2009. This period of delay is 813 days.

7. The following statements are required by 37 CFR § 1.705(b)(2)(iv)(A) and list circumstances during the prosecution of this application constituting a failure to engage in reasonable efforts to conclude processing or examination of the above-identified patent application as set forth in § 1.704.

- i) The Response to Notice to file Missing Parts filed September 15, 2004 was filed after the three month period for filing a response. Under § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of the mailing of the Notice to File Missing Parts on June 1, 2004 and ends on the date the reply was filed. Thus, the period of delay runs from September 1, 2004 to September 15, 2004. Thus this period of delay is 14 days.
- ii) The Information Disclosure Statement filed February 8, 2008 under 37 CFR §§ 1.56, 1.97 and 1.98 was filed after the Response to

Restriction Requirement was filed on December 4, 2007. Under § 1.703(c), the period of adjustment for delay associated with this submission begins on the day after the date the Response to Restriction Requirement was filed and ending on the date that the Information Disclosure Statement was filed. Thus, the period of delay runs from December 4, 2007 to February 8, 2008. This period of delay is 66 days.

- iii) The Amendment and Response to the Non-Final Office Action filed August 22, 2008 was filed after the three month period for filing a response. Under § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of the mailing of the Non-Final Rejection on February 22, 2008 and ends on the date the reply was filed. Thus, the period of delay runs from May 22, 2008 to August 22, 2008. Thus this period of delay is 92 days.
- iv) The Information Disclosure Statement filed September 17, 2008 under 37 CFR §§ 1.56, 1.97 and 1.98 was filed after the Response to Non-Final Office Action was filed on August 22, 2008. Under § 1.703(c), the period of adjustment for delay associated with this submission begins on the day after the date the Response to Non-Final Office Action was filed and ending on the date that the Information Disclosure Statement was filed. Thus, the period of delay runs from August 22, 2008 to September 17, 2008. This period of delay is 26 days.
- v) The Amendment and Response filed June 3, 2009 under 37 CFR § 1.111 was filed after the three month period for filing a response. Under § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months

after the date of the mailing of the Final Office Action on December 3, 2008 and ends on the date the reply was filed. Thus, the period of delay runs from March 3, 2009 to June 3, 2009. Thus this period of delay is 92 days.


- (vi) The Amendment and Response filed December 17, 2009 under 37 CFR § 1.111 was filed after the three month period for filing a response. Under § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of the mailing of the Non-Final Office Action on June 17, 2009 and ends on the date the reply was filed. Thus, the period of delay runs from September 17, 2009 to December 17, 2009. Thus this period of delay is 91 days.

8. Any patent granted on this application may be subject to a terminal disclaimer. See 37 CFR § 1.705(b)(2)(iii)

9. Applicant reserves the right to file a supplemental Request for Correction of PTA under 37 CFR § 1.705(d) in the event the patent issues on a date other than September 13, 2010.

Respectfully submitted,

Date: 7/1/10

  
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J. Clinton Wimbish  
Reg. No. 54,545

Encl. - Exhibit A - Copy of PTA History for Application No. 10/801,140 Printed from PAIR April 27, 2010

## EXHIBIT A

10/801,140 CATALYST SYSTEMS

04-27-  
2010::09:37:29**Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 10/801,140

Filing or 371(c) Date:	03-12-2004	USPTO Delay (PTO) Delay (days):	-
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	-	Applicant Delay (APPL) Delay (days):	-
Post-Issue Petitions (days):	-	Total PTA (days):	494
USPTO Adjustment(days):	-	Explanation Of Calculations	

**Patent Term Adjustment History**

Date	Contents Description	PTO(Days)	APPL(Days)
04-16-2010	Mail Notice of Allowance		
04-15-2010	Document Verification		
04-15-2010	Notice of Allowance Data Verification Completed		
04-12-2010	Examiner's Amendment Communication		
04-09-2010	Date Forwarded to Examiner		
04-08-2010	Amendment after Final Rejection		
03-31-2010	Mail Examiner Interview Summary (PTOL - 413)		
03-15-2010	Examiner Interview Summary Record (PTOL - 413)		
03-17-2010	Mail Final Rejection (PTOL - 326)		
03-15-2010	Final Rejection		
01-08-2010	Date Forwarded to Examiner		
12-17-2009	Response after Non-Final Action		91
12-17-2009	Request for Extension of Time - Granted		⬆
06-17-2009	Mail Non-Final Rejection		⬆
06-17-2009	Non-Final Rejection		
06-05-2009	Date Forwarded to Examiner		
06-05-2009	Date Forwarded to Examiner		
06-03-2009	Request for Continued Examination (RCE)		92
06-05-2009	Disposal for a RCE / CPA / R129		⬆
06-03-2009	Request for Extension of Time - Granted		⬆
06-03-2009	Workflow - Request for RCE - Begin		⬆
12-03-2008	Mail Final Rejection (PTOL - 326)		⬆
12-02-2008	Final Rejection		
09-17-2008	Information Disclosure Statement considered		
09-17-2008	Information Disclosure Statement (IDS) Filed		26
09-25-2008	Date Forwarded to Examiner		⬆
08-22-2008	Response after Non-Final Action		92
08-22-2008	Request for Extension of Time - Granted		⬆
08-22-2008	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		⬆
08-22-2008	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		⬆
09-17-2008	Information Disclosure Statement (IDS) Filed		⬆

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02-08-2008	Miscellaneous Incoming Letter	↑	
02-08-2008	Information Disclosure Statement (IDS) Filed	66	↑
02-22-2008	Mail Non-Final Rejection	↑	
02-19-2008	Non-Final Rejection	↑	
09-13-2005	Information Disclosure Statement considered	↑	
02-08-2008	Information Disclosure Statement considered	↑	
02-08-2008	Information Disclosure Statement (IDS) Filed	↑	
12-18-2007	Date Forwarded to Examiner	↑	
12-04-2007	Response to Election / Restriction Filed	↑	
12-04-2007	Request for Extension of Time - Granted		
11-26-2007	Case Docketed to Examiner in GAU		
10-17-2007	Withdraw Flagged for 5/25		
10-16-2007	Flagged for 5/25		
10-04-2007	Mail Restriction Requirement	875	
10-01-2007	Requirement for Restriction / Election	↑	
09-25-2007	Case Docketed to Examiner in GAU	↑	
09-22-2005	Correspondence Address Change	↑	
09-13-2005	Reference capture on IDS	↑	
09-13-2005	Information Disclosure Statement (IDS) Filed	↑	
09-13-2005	Information Disclosure Statement (IDS) Filed	↑	
02-01-2005	IFW TSS Processing by Tech Center Complete	↑	
02-01-2005	Case Docketed to Examiner in GAU	↑	
10-01-2004	Application Return from OIPE	↑	
10-01-2004	Application Return TO OIPE	↑	
10-01-2004	Application Return from OIPE	↑	
10-01-2004	Application Is Now Complete	↑	
10-01-2004	Application Return TO OIPE	↑	
09-29-2004	Application Return from OIPE	↑	
09-29-2004	Application Is Now Complete	↑	
09-29-2004	Application Return TO OIPE	↑	
09-29-2004	Application Dispatched from OIPE	↑	
09-29-2004	Application Is Now Complete	↑	
09-15-2004	Payment of additional filing fee/Preexam	14	
09-15-2004	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	↑	
06-01-2004	Notice Mailed--Application Incomplete--Filing Date Assigned	↑	
04-10-2004	Cleared by OIPE CSR		
03-24-2004	IFW Scan & PACR Auto Security Review		
03-12-2004	Initial Exam Team nn		

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